

Remarks

Claims 1-26 were pending in the application. All the pending claims were rejected for the various reasons described in the Office Action and summarized below. Claim 25 has been amended to more clearly define the invention. Claims 1, 10, 15 and 25 are the independent claims.

Initially, the Applicant filed an information disclosure statement on August 11, 2004 and a signed initial copy of the information disclosure statement has not been received. The Applicant respectfully requests that the Examiner consider all of the cited references and provide a copy of the signed information disclosure statement.

The Examiner objected to the specification as having an abstract that exceeds 150 words in length. A new abstract that is less 150 has been provided and the Applicant respectfully requests the withdrawal of the objection to the specification.

The Examiner rejected under 35 USC 103(a) claims 1-24 as being unpatentable over *Zigmond et al.* (USP 6,698,020) in view of *Alexander et al.* (USP 6,177,931) and claims 25 and 26 as being unpatentable over *Zigmond et al.* in view of *Alexander et al.* and *Klosterman et al.* (USP 6,078,348).

Independent claim 1 is directed to a method for delivering targeted advertising in recorded programming. The method includes receiving a schedule of programming to be recorded and identifying subscribers that are likely to view the recorded programming. Subscriber profiles associated with the identified subscribers are retrieved and a targeted advertisement is delivered to the identified subscribers.

It is submitted that none of the cited references, either alone or in combination, disclose or suggest the embodiment of claim 1. For example, none of the cited references, whether taken alone or combination with one another, disclose or suggest receiving a schedule of programming to be recorded and identifying subscribers likely to view the recorded programming.

Rather, *Zigmond et al.* disclose a method for delivering advertising to subscribers. The system selects advertisements to deliver to a recorded program to prevent advertisements that have time sensitive material from being inserted into a program that is watched at a later date

Amendment

-7-

09/680,622

(see col. 14, lines 1-13). Furthermore, advertisements may be selected based upon demographic information stored in the viewer's equipment (see col. 14, lines 35-48). Thus, *Zigmond et al.* disclose selecting advertisement for programming that is recorded based upon either the time sensitivity of the advertisement or on demographic information stored on the viewer's equipment. Therefore, *Zigmond et al.* clearly fail to teach or suggest a method for delivering targeted advertisements including receiving a schedule of programming to be recorded and identifying subscribers likely to view the recorded program.

Alexander et al. disclose an Electronic Program Guide (EPG) that includes advertisements displayed with the EPG that are customized based upon a viewer's profile and does not disclose delivering targeted advertisements in recorded programming. Therefore, *Alexander et al.* fail to alleviate the deficiencies of *Zigmond et al.* and clearly fail to teach or suggest a method for delivering targeted advertisements including receiving a schedule of programming to be recorded and identifying subscribers likely to view the recorded program.

Moreover, even assuming arguendo that the Examiner could somehow construe *Alexander et al.* to disclose receiving a schedule of programming to be recorded and identifying subscribers likely to view the recorded programming (without acknowledging or conceding such), the Examiner's motivation to combine the references is erroneous. The Examiner states (see p. 4 of the Office Action) that the teachings of *Alexander et al.* benefit *Zigmond et al.* for the benefit of "enabling users to designate programming for recording so the user can later watch said programming whenever the user desires." The Applicant respectfully submits that it is unclear as to how the alleged advantages improve the system of *Zigmond et al.* because in the system of *Zigmond et al.* the user is capable of recording programming to watch whenever the user desires.

Klosterman et al. disclose an enhanced EPG that includes areas to display program schedule information, movie listings and has enhanced recording capabilities. However, *Klosterman et al.* does not disclose delivering targeted advertisements to subscribers for programming that is to be recorded. Therefore, *Klosterman et al.* fail to alleviate the deficiencies of *Zigmond et al.* and clearly fail to teach or suggest a method for delivering targeted

advertisements including receiving a schedule of programming to be recorded and identifying subscribers likely to view the recorded program.

Moreover, even assuming *arguendo* that the Examiner could somehow construe *Klosterman et al.* to disclose receiving a schedule of programming to be recorded and identifying subscribers likely to view the recorded programming (without acknowledging or conceding such), the Examiner's motivation to combine the references is erroneous. The Examiner states (see p. 12 of the Office Action) that the teachings of *Klosterman et al.* benefit *Zigmond et al.* for the benefit of "providing the device with ad scheduling information well ahead of time, which would make the system less processor intensive, alleviating the requirement to calculate a new ad to insert at each and every opportunity." The Applicant respectfully submits that it is unclear as to how the alleged advantages improve the system of *Zigmond et al.* because it is unclear as to how receiving scheduling information in advance reduces the processing necessary to insert and advertisement. *Zigmond et al.* disclose (col. 14, lines 1-13) that the advertisements need to be replaced at the time of viewing in order to ensure that advertisements with time sensitive material are not displayed. Thus, receiving scheduling in advance does not change the operation of *Zigmond et al.*

For at least the reasons addressed above, it is submitted that independent claim 1 is clearly patentable over the cited references. Claims 2-9 depend from independent claim 1. It is submitted that claims 2-9 are clearly patentable over the cited references for the reasons addressed above with respect to claim 1 and for the further features recited therein.

Independent claim 10 is directed to a method for delivering targeted advertising in recorded programming. The method includes programming a recording device to record one or more television programs and generating a schedule of programs to record. Potential subscribers of the television program are identified and characterized and a schedule of a targeted advertisement to be delivered is generated. The targeted advertisement is delivered to the potential subscribers.

It is submitted that none of the cited references, either alone or in combination, disclose or suggest the embodiment of claim 10. For example, none of the cited references, whether taken alone or combination with one another, disclose or suggest generating a schedule of

television programs to be recorded and identifying potential subscribers of the television programming.

Rather, *Zigmond et al.* disclose a method for delivering advertising to subscribers. The system selects advertisements to deliver to a recorded program to prevent advertisements that have time sensitive material from being inserted into a program that is watched at a later date (see col. 14, lines 1-13). Furthermore, advertisements may be selected based upon demographic information stored in the viewer's equipment (see col. 14, lines 35-48). Thus, *Zigmond et al.* disclose selecting advertisement for programming that is recorded based upon either the time sensitivity of the advertisement or on demographic information stored on the viewer's equipment. Therefore, *Zigmond et al.* clearly fail to teach or suggest a method for delivering targeted advertisements including generating a schedule of television programs to be recorded and identifying potential subscribers of the television programs.

Alexander et al. disclose an Electronic Program Guide (EPG) that includes advertisements displayed with the EPG that are customized based upon a viewer's profile and does not disclose delivering targeted advertisements in recorded programming. Therefore, *Alexander et al.* fail to alleviate the deficiencies of *Zigmond et al.* and clearly fail to teach or suggest a method for delivering targeted advertisements including generating a schedule of television programs to be recorded and identifying potential subscribers of the television programs.

Moreover, even assuming arguendo that the Examiner could somehow construe *Alexander et al.* to disclose receiving a schedule of programming to be recorded and identifying subscribers likely to view the recorded programming (without acknowledging or conceding such), the Examiner's motivation to combine the references is erroneous. The Examiner states (see p. 4 of the Office Action) that the teachings of *Alexander et al.* benefit *Zigmond et al.* for the benefit of "enabling users to designate programming for recording so the user can later watch said programming whenever the user desires." The Applicant respectfully submits that it is unclear as to how the alleged advantages improve the system of *Zigmond et al.* because in the system of *Zigmond et al.* the user is capable of recording programming to watch whenever the user desires.

Klosterman et al. disclose an enhanced EPG that includes areas to display program schedule information, movie listings and has enhanced recording capabilities. However, *Klosterman et al.* does not disclose delivering targeted advertisements to subscribers for programming that is to be recorded. Therefore, *Klosterman et al.* fail to alleviate the deficiencies of *Zigmond et al.* and clearly fail to teach or suggest a method for delivering targeted advertisements including generating a schedule of television programs to be recorded and identifying potential subscribers of the television programs.

Moreover, even assuming arguendo that the Examiner could somehow construe *Klosterman et al.* to disclose receiving a schedule of programming to be recorded and identifying subscribers likely to view the recorded programming (without acknowledging or conceding such), the Examiner's motivation to combine the references is erroneous. The Examiner states (see p. 12 of the Office Action) that the teachings of *Klosterman et al.* benefit *Zigmond et al.* for the benefit of "providing the device with ad scheduling information well ahead of time, which would make the system less processor intensive, alleviating the requirement to calculate a new ad to insert at each and every opportunity." The Applicant respectfully submits that it is unclear as to how the alleged advantages improve the system of *Zigmond et al.* because it is unclear as to how receiving scheduling information in advance reduces the processing necessary to insert and advertisement. *Zigmond et al.* disclose (col. 14, lines 1-13) that the advertisements need to be replaced at the time of viewing in order to ensure that advertisements with time sensitive material are not displayed. Thus, receiving scheduling in advance does not change the operation of *Zigmond et al.*

For at least the reasons addressed above, it is submitted that independent claim 10 is clearly patentable over the cited references. Claims 11-14 depend from independent claim 10. It is submitted that claims 11-14 are clearly patentable over the cited references for the reasons addressed above with respect to claim 10 and for the further features recited therein.

Independent claim 15 is directed to a system for delivering targeted advertising in recorded programming. The system includes a recording schedule module that obtains a schedule of programs to be recorded and a subscriber identification module for identifying

possible subscribers that will view the programs. An ad-scheduling module generates a targeted ad to be inserted into the programs.

As discussed above with respect to claim 10, it is submitted that none of the cited references, either alone or in combination, disclose or suggest the embodiment of claim 15. For example, none of the cited references, whether taken alone or combination with one another, disclose or suggest a subscriber identification module for identifying possible subscribers that will view programs scheduled to be recorded.

For at least the reasons addressed above, it is submitted that independent claim 15 is clearly patentable over the cited references. Claims 16-24 depend from independent claim 15. It is submitted that claims 16-24 are clearly patentable over the cited references for the reasons addressed above with respect to claim 10 and for the further features recited therein.

Independent claim 25 is directed to a method for delivering targeted advertisements in programs that have been flagged for future viewing. The method includes receiving notification that a program has been flagged for future viewing and generating a schedule which includes avails within the flagged program. Potential subscribers of the flagged program are identified. A schedule of targeted advertisements to be delivered in the flagged program is generated the targeted advertisements are delivered.

As discussed above with respect to claim 10, it is submitted that none of the cited references, either alone or in combination, disclose or suggest the embodiment of claim 25. For example, none of the cited references, whether taken alone or combination with one another, disclose or suggest receiving notification that a program has been flagged for future viewing and identifying a potential subscribers of the flagged program.

For at least the reasons addressed above, it is submitted that independent claim 25 is clearly patentable over the cited references. Claim 26 depends from independent claim 25. It is submitted that claim 26 is clearly patentable over the cited references for the reasons addressed above with respect to claim 25 and for the further features recited therein.

Conclusion

For the foregoing reasons, Applicant respectfully submits that claims 1-26 are in condition for allowance. Accordingly, early allowance of claims 1-26 is earnestly solicited.

Should the Examiner believe that an Interview would help expedite prosecution of the application, the Examiner is requested to contact the undersigned attorney to schedule such an Interview.

Respectfully submitted,



Craig Hallacher
Reg. No. 54,896

Date: 11/16/04

Technology, Patents & Licensing, Inc.
6206 Kellers Church Road
Pipersville, Pa 18947
phone: (215)766-2100 (x127)
fax: (215)766-2920